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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,463

11/21/2003

Bruce A. Williams

3044-73785

2599

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EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

10/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,463	<b>Applicant(s)</b> WILLIAMS, BRUCE A.	
	<b>Examiner</b> Mathieu D. Vargot	<b>Art Unit</b> 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to recite that "no part of the image-carrying sheet is situated in the disk-like portion" and this language cannot be found in the specification as filed. Negative limitations require clear support in the specification because without it, applicant would merely be able to exclude something that the reference has and is not taught by applicant to show patentability or non-obviousness. Unless this aspect has been expressly gone into and discounted by applicant, it is not proper to do this. The mere fact that the drawings do not show such a feature would not in and of itself be sufficient to provide this support. Applicant needs to point out where in the specification clear written support exists for this limitation or delete it from the claims.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirata et al essentially for reasons of record noting the following. While applicant has amended the claims in a manner to "get around" Hirata et al, it is believed that the

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limitation set forth to do this in fact constitutes new matter and hence the 102 rejection has been maintained.

3.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata et al generally for reasons as set forth in paragraph 3 of the previous rejection and paragraph 2, supra noting the following. In the event that the claim amendments are not deemed to be new matter, it is respectfully submitted that the aspect of "no part of the... sheet" being situated in the disk-like portion of the plastic-receiving space would have been obvious over Hirata et al. Clearly, this amounts to no more than a design choice for the image-carrying sheet that one of ordinary skill in the art would have easily modified dependent on the exact image desired and stability for the sheet during the injection. The sheet of Hirata et al would be more stable, but one of ordinary skill would have eliminated the additional portion of the sheet that occupies the disk-like portion of the cavity should this be desired.

4.Claims 6, 7, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata et al in view of Raymond et al 2005/0053737 for reasons of record as set forth in paragraph 4 of the last office action and paragraph 2, supra.

5. Applicant's arguments filed June 28, 2007 have been fully considered but they are not persuasive. Applicant submits that the claim amendments define over Hirata et al. For reasons already noted, such is not persuasive. First of all, it is believed that the amendments constitute new matter, in that the aspect of the sheet not containing any portion situated in the disk-like portion of the cavity was never explicitly disclosed in the instant specification. Secondly, if it is not new matter, than it is submitted that this aspect would have been obvious over Hirata et al. One of ordinary skill in this art knows of the various sheet designs for labels and image-carrying films and would have been readily able to pick and choose whatever suitable design desired.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot  
September 29, 2007

  
Mathieu D. Vargot  
Primary Examiner  
Art Unit 1732

9/29/07